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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,147	02/17/2004	David Banks	112-0146US	2277
29855	7590	10/18/2005		
WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, P.C. 20333 SH 249 SUITE 600 HOUSTON, TX 77070			EXAMINER HARPER, KEVIN C	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/780,147

Applicant(s)

BANKS ET AL.

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/17/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/04, 10/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 9-10, 12-16, 18-19 and 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of U.S. Patent No. 6,765,919.

Claims 1, 4, 9-10, 15-16 and 18-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 or 31 of copending Application No. 10/059,753. This is a provisional obviousness-type double patenting rejection.

Claims 1, 4, 9-10, 12-16, 18-19 and 22-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of copending Application No. 10/853,321. This is a provisional obviousness-type double patenting rejection.

1. Regarding claims 1, 4, 9-10, 15-16 and 18-19, claims 1, 7 or 12 of the '919 patent or the '321 application or claim 10 of the '753 application recites all the limitations and in addition returning an address for members of a common zone. In removing the additional limitation, the

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scope of the claims is merely broadened by eliminating elements and their functions. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite returning an address for members of a common zone.

2. Regarding claims 12-14 and 23-24, claim 4 and 10, respectively, of the '919 patent or the '321 application recites this limitation.

3. Regarding claim 22, claims 13 and 14 of the '919 patent or the '321 application recite this limitation.

Claims 2, 5-8, 11, 14, 17 and 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of U.S. Patent No. 6,765,919, as applied above, in further view of Berman (US 2003/0095549).

Claims 2, 5-8, 11, 14, 17 and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of copending Application No. 10/853,321, as applied above, in further view of Berman (US 2003/0095549). This is a provisional obviousness-type double patenting rejection.

4. Regarding claims 2, 11, 14 and 17, the '919 patent or the '321 application does not recite several configurations. Berman discloses several configurations (para. 175). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite several

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configurations in '919 patent or the '321 application in order to reflect the current topology of the network (Berman, para.175, lines 1-7).

5. Regarding claims 5-8 and 20-22, the '919 patent or the '321 application does not recite a worldwide name or an ALPA. Berman discloses a worldwide name (paras. 97, 104, 166) and an ALPA (para. 8). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a worldwide name in the '919 patent or the '321 application in order to provide for Fibre Channel compatibility (Berman, para. 16).

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of U.S. Patent No. 6,765,919, as applied to claim 1 above, in further view of Witkowski et al. (US 6,665,733).

Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 10 and 12 of copending Application No. 10/853,321, as applied to claim 1 above, in further view of Witkowski et al. (US 6,665,733).

6. Regarding claim 3, claim 1 of the '919 patent or the '321 application does not disclose a non-volatile memory. Witkowski discloses a non-volatile memory (col. 18, lines 25-34) having VLAN configuration assignments. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a non-volatile memory in the '919 patent or the '321 application in order to retain data after a power failure (Witkowski, col. 18, lines 23-26).

***Allowable Subject Matter***

7. Claims 1-24 would be allowable if the above double patenting rejections are overcome.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 571-272-3166. The examiner can normally be reached weekdays from 11:00 AM to 7:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 571-272-3174. The centralized fax number for the Patent Office is 571-273-8300. For non-official communications, the examiner's personal fax number is 571-273-3166 and the examiner's e-mail address is kevin.harper@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications associated with a customer number is available through Private PAIR only. For more information about the PAIR system, see portal.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin C. Harper

October 17, 2005